



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8
09-18-02
DW

Re Application of BORNHORST ET AL.)

) Art Unit: 1761

Serial Number: 09/544,349

) Examiner: Corbin, A.

Filed: April 6, 2000

) Atty Docket: 5282USA

For: FOOD PRODUCT METHOD OF PREPARATION

RESPONSE

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

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This paper is filed in response to the Office Action dated June 11, 2002 issued in the above-identified U.S. patent application. In view of the following remarks, reconsideration of the application is respectfully requested.

In the outstanding Office Action, the Examiner has essentially duplicated his prior rejection of the claims under the judicially created doctrine of obviousness-type double patenting and in view of the prior art of GB patent 1,050,307 either taken singly or in combination with either of the patents to Matz or Schwab et al. Furthermore, the Examiner has set forth new rejections of the claims based on U.S. Patent No. 6,291,008 or WO99/41998 to Robie et al. In general, in the amendment/response filed on April 17, 2002, the Applicant expressed a willingness to prepare and file a terminal disclaimer to overcome the double patenting rejection, regardless of perceived differences between at least many of the claims in the present application versus that set forth in U.S. Patent No. 6,291,008, in order to further prosecution in this case. However, it was deemed important that the Examiner first realize the patentability of the present claims over the same prior art to which the '008 patent was allowed. That is, the positions taken by the Examiner are

totally inconsistent with prior PTO judgments. On the one hand, the Examiner is stating that the claims in the present application cover inventive aspects which are not patentably distinct from that set forth in U.S. Patent No. 6,291,008, while on the other hand the Examiner is rejecting those same claims under the same prior art over which the '008 patent claims were allowed. If the claims in the present case are considered by the Examiner to not be patentably distinct over those set forth in U.S. Patent No. 6,291,008, then the present claims should be clearly allowable over the art relied upon by the Examiner for the same reasons as the claims were allowed in the '008 patent. SPE Milton Cano played an instrumental part in identifying the patentable distinctions between the known prior art, particularly GB patent 1,050,307, and the claims now presented in the '008 patent. It would only stand to reason that if the Examiner feels an obviousness-type double patenting rejection is appropriate, a rejection based on the same prior art is correspondingly inappropriate. Certainly, if the Examiner continues to maintain both of these contrary rejections, a justification for this inconsistency is requested. Regardless, based on the remarks previously presented to the Examiner in the prior amendment/response and in view of the further remarks presented below, it is respectfully submitted that the known prior art clearly does not suggest the present invention.

Based on the comments presented by the Examiner in §11 of the outstanding Office Action, it appears that, in attempting to read the GB patent disclosure on the present claims, the Examiner is equating one cooking step set forth in the GB patent to the Applicant's two step cooking process. By this, the Applicant believes that the Examiner is somehow dividing the cooking process set forth in the British Patent such that it actually constitutes multiple cooking processes which are performed in series. Apparently the Examiner is holding that "This is especially true since there are no claim distinctions between Applicant's first and second cooking steps." It is respectfully submitted that this statement is inaccurate and that there are significant differences between the first and second cooking steps which prevents the Examiner from simply subdividing a single cooking step to meet these limitations. First of all, under the same

logic utilized in rejecting the claims, a single cooking process could actually be constituted by an infinite number of successive cooking steps. It is respectfully submitted that this is an unreasonable interpretation of the claims. Secondly, the claims in the present application cannot be read in a vacuum but must be done so in light of the specification. Clearly the specification sets forth, and actually specifically defines, what is meant by "immediately thereafter" in referring to the second cooking step. To this end, the Examiner's attention is drawn to a discussion of a preferred first cooking step starting on page 10, line 24 and continuing through onto page 12, line 18. Starting on line 19 of page 12, a discussion is made regarding the second cooking step. The first full paragraph on page 13 provides a specific meaning for the phrase "immediately thereafter" in accordance with the invention. It is respectfully submitted that the Examiner, in light of the disclosure, interpret the first and second cooking steps as distinct cooking steps, as opposed to simply subdividing a single cooking step. In addition, it is further respectfully submitted that independent claim 1 does provide limitations which further set forth distinctions between the first and second cooking steps. The first cooking step is limited to be performed in a cooker extruder and is performed for a period which provides at least a partially cooked cereal mass or dough while also requiring the addition of sufficient amounts of moisture during the step. On the other hand, the second cooking step is done at a specified temperature range and for a specified period. Claim 1 clearly sets forth that the second cooking step is an extended time cooking step.

In addition to these distinctions, the Examiner has indicated in the Office Action that, when a cooked cereal is formed in accordance with the disclosure in the British patent, bran and germ particles will be visible and that these visible particles are "substantially equivalent" to Applicant's claimed discernible grain bits. Respectfully, there is absolutely no disclosure in GB1,050,307 to preparing a snack product from a cooked cereal dough wherein grain pieces are formed into a cooked cereal dough having discernible grain bits from originally provided cereal grain pieces and then further subjecting that dough to a second, extended time period cooking step in a manner which

maintains those same discernible grain bits. Instead, GB1,050,307 only has a single cooking step utilizing an extruder which, based on the subject matter being claimed, can only be considered generally analogous to step B in independent claim 1. Immediately after the "oat flake" is extruded as a dough, it is cut into pellets and immediately rolled into flakes in accordance with the '307 reference. At best, the flakes are then dried. Therefore, there is no teaching in this prior art patent document which would suggest that the extruded dough should even be subjected to a second cooking step, let alone one in a range of 120-194°C for about 15-45 minutes to form an extended time cooking cereal dough which still maintains the discernible grain bits, from the original cereal grain pieces dispersed therein as required by claim 1. Again, these distinctions were set forth to the Examiners in charge of U.S. Patent No. 6,291,008 and the Patent Office has already, correctly identified this claimed subject matter as being patentably distinct from the teachings in this GB reference. For all these reasons, withdrawal of this rejection is respectfully requested.

Of course, with the withdrawal of the main reference, all the claims in the application should be allowable over this known prior art, including the Matz and Schwab et al. references. However, with respect to the addition of the Matz patent, the Examiner has indicated that Matz discloses that the steeping of grain prior to processing thereof is conventional such that it would be obvious to do so in connection with the disclosure of the British patent. However, as previously presented to the Examiner but not addressed in the Office Action, GB patent 1,050,307 specifically teaches to only have water present "in an amount less than that amount necessary to provide a substantial unabsorbed water phase..." (see column 1, line 83 through column 2, line 1). If the grains were steeped prior to processing, this specific teaching would be destroyed. That is, you cannot steep the grains and have water present in an amount less than the amount necessary to provide a substantial unabsorbed water phase. Instead, these two aspects are contrary to each other such that one of ordinary skill in the art would not look to modify the British disclosure and employ steeping, regardless of whether steeping is known in

connection with forming other products. It is previously submitted that employing the steeping in Matz to the British disclosure would materially alter or destroy the product produced. If the Examiner is going to continue applying this combination, it is respectfully submitted that he particularly point out the error in this position.

With respect to the rejection of claim 28 based on the British patent in further view of Schwab et al., the Applicant made specific arguments beginning on the bottom of page 8 and continuing on to the top of page 9 in the prior response. That is, it is questioned of the Examiner why one of ordinary skill in the art would look to modify the GB reference to employ microwave heating as there is no stated advantage achieved and, in fact, this change would materially alter the product produced. This argument was not at all addressed by the Examiner in the Office Action. In any event, to further emphasize this point, again the Examiner's attention is drawn to the teachings in the British patent concerning the desired minimal amount of water being present. Microwaving a product which has an extremely low moisture content presents significant problems as the microwave heating typically acts on the water molecules.

Finally, the Examiner has set forth three new rejections in this case concerning the use of Robie et al. WO99/41998 and/or U.S. Patent No. 6,291,008. Since the present application represents a continuation-in-part of the prior U.S. application that resulted in U.S. Patent No. 6,291,008, and the World publication is based on the U.S. application resulting in the '008 patent, the common subject matter between the present application and that set forth in the '008 disclosure would have the same effective date. Clearly, the first page of the present application sets forth that this case represents a continuation-in-part application. Initially, it was unclear to the Applicant why the Examiner introduced these new rejections at this time and made a second non-final. However, it was later determined that the Examiner apparently recognized that the declaration submitted in response to the notice of missing parts did not properly claim priority from the parent application. To this end, the application as originally drafted and further amended on

April 17th has been forwarded to the inventors in connection with executing a new declaration which appropriately claims the priority for this case. Therefore, a new declaration will be submitted to the Examiner as soon as possible. It is believed that the submission of this new declaration with the appropriate priority claim will clearly overcome the rejections set forth in §§8-10 of the Office Action.

Still, the Applicant does question the Examiner's statement that the Robie et al. reference is available as prior art "since Applicant's claims are not fully supported by parent patent 6,291,008." Obviously, the Examiner recognizes a "parent patent". In any event, the Examiner lists many claim limitations which are "not supported". Regardless of setting forth various limitations which are deemed to be not supported, rejections are still being made under §102. Therefore, there seems to be some discrepancy in the prior art being held to clearly anticipate the claimed subject matter, but yet the prior disclosure is not supporting various claimed limitations. The same is true with respect to the rejection of many of the claims under U.S. Patent No. 6,291,008 to Robie et al.

Regardless, it is considered that the declaration and the proper acknowledgment of priority for this case will overcome these matters. If the Examiner then is ready to drop the rejections based on the British patent document for the same reasons that Examiners Dubois and Cano allowed the application resulting in U.S. Patent No. 6,291,008, the Examiner is cordially invited to contact the undersigned at the number provided below to submit a terminal disclaimer in order to place the entire application in clear condition for allowance. Unfortunately, since the claim limitations are not identical and the Applicant actually disagrees with the double patenting rejection for at least some of the claims in this case, the Applicant is not willing to submit a terminal disclaimer absent the withdrawal of the rejections based on the same prior art relied upon in the parent case.

Based on the above remarks, it is hopeful that the Examiner realizes that the Applicant is attempting to place this application in clear condition for allowance and is both ready and willing to work with the Examiner to this end. Therefore, the Examiner is

cordially invited to contact the undersigned at the number provided below if the undersigned can be of any further assistance in furthering the prosecution of this application to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Everett G. Diederiks, Jr.", written in a cursive style.

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